

REMARKS

The Official Action of May 18, 2006, has been carefully reviewed. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

No claims have been amended. Claims 57-61 have been withdrawn as being directed to a non-elected invention. The claims under consideration are Claims 42-56.

I. Restriction Requirement

Under 35 U.S.C. 121, the Examiner required restriction among:

- I. Claims 42-56, drawn to a process of making 3-chloromethyl-1,2,4-triazolin-5-one; and
- II. Claims 57-61, drawn to a substantially pure compound of formula III.

In response to this requirement, the Applicants previously elect Group I drawn to a process of making 3-chloromethyl-1,2,4-triazolin-5-one. Although the Applicants maintain that the claims should not be subject to restriction, in the interest of compact prosecution they have amended the claims to be directed to the elected and examined subject matter as requested by the Examiner.

This election is being taken without prejudice to the filing of a divisional application directed to the non-elected subject matter. In accordance with the third sentence of 35 U.S.C. § 121, a patent issuing from the instant application should not be a reference against a divisional application filed before the issuance of such patent. As the Examiner noted, Applicants preserve the right to file divisional applications on the remaining subject matter.

II. Rejection of Claims 42-56 under 35 U.S.C. § 103(a) over Cowden

Claims 42-56 stand rejected under 35 U.S.C. § 103(a) for being obvious over Cowden et al., WO 01/96315.

The Applicants respectfully traverse this rejection and provide the following comments. The Applicants respectfully assert that the cited references do not disclose or suggest the claimed invention. Nor would the cited references have motivated or enabled one skilled in the art to employ the subject compounds in accordance with the claimed invention. Moreover, in view of the state of the art, there would have been no reasonable expectation of success and one skilled in the art would have been discouraged from using a sulfonate salt of semicarbazide to prepare 3-chloromethyl-1,2,4-triazolin-5-one in accordance with the process of the claimed invention.

As discussed in the Specification (page 1, line 9 to page 2, line 10), the process of Cowden et al., WO 01/96315, employs the hydrochloride salt of semicarbazide. This reaction takes about 3 days, which is very time consuming for large scale or industrial use.

The present invention claims the use of a sulfonate salt of semicarbazide to prepare 3-chloromethyl-1,2,4-triazolin-5-one. Accordingly, the claimed process is distinct from the methods of Cowden et al. As the Examiner recognized, Cowden et al does not specifically disclose or suggest the use of a sulfonate salt of semicarbazide to prepare 3-chloromethyl-1,2,4-triazolin-5-one. The generic teaching of "salt thereof" is not sufficient to disclose or suggest the use of a sulfonate salt of semicarbazide.

Nothing in Cowden et al. discloses or suggests that the reactant sulfonate salt of semicarbazide may be successfully reacted under the claimed conditions to provide the product 3-chloromethyl-1,2,4-triazolin-5-one.

Thus, Applicants respectfully submit that Cowden et al. would have failed to provide the requisite guidance for one of ordinary skill in the art to have successfully reacted sulfonate salt of semicarbazide under the claimed conditions to obtain the product 3-chloromethyl-1,2,4-triazolin-5-one.


Moreover, as disclosed in the Specification (page 1, line 28 to page 2, line 10), the present invention provides unexpected benefits relative to Cowden et al.

In accordance with the present invention, the use of alkyl or aryl sulfonic acid salts of semicarbazide, such as the methanesulfonic (mesylate) or para-toluenesulfonic (tosylate) salts of semicarbazide, surprisingly results in improved reaction yields, shorter reaction times, no detectable decomposition of orthoester and greater purity of the final product. Also, by the use of sulfonic acid salts, it is possible to elevate the reaction temperature. Additionally, the reaction time is reduced considerably compared to conventional routes disclosed by Cowden et al. These unexpected benefits are not disclosed or suggested by Cowden et al.

The Applicant respectfully asserts that the rejection of Claims 42-56 under 35 U.S.C. § 103(a) for being obvious over Cowden et al., WO 01/9631 is untenable and should be withdrawn.

The Applicant respectfully contends that the application is allowable and a favorable response from the Examiner is earnestly solicited.

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